THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Kazuyoshi Kikuta

Appeal No. 96-1254
Application 07/642,575[1]

ON BRIEF

Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 and 2. Claims 3 through 12 have been allowed.

[1] Application for patent filed January 17, 1991.

The invention is directed to a method and apparatus for reading a synchronizing signal of a recording medium.

Independent method claim 1 is reproduced as follows:

1. A method of reading a synchronizing signal of a recording medium having a sector in which an address portion and a data portion are recorded, said data portion having synchronizing pattern data at a front part thereof, and a plurality of divided data portions and re-synchronizing pattern data between the divided data portions, said method comprising the steps of:

detecting said synchronizing pattern data;

determining if the detection of the synchronized pattern data is successful;

setting a predetermined time period to be a first time period if said detection is successful, and a second time period, longer than said first time period, if said detection is unsuccessful; and

detecting the re-synchronizing pattern data within said predetermined time period.

The examiner relies on the following references:

Aoshima et al. (Aoshima)	4,908,812	Mar. 13, 1990
Ichinoi et al. (Ichinoi) (Japan, Kokai)[2]	61-292270	Dec. 23, 1986

Claims 1 and 2 stand rejected under 35 U.S.C. 103. As evidence of obviousness, the examiner cites Ichinoi in view of Aoshima.

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[2]Our understanding of this reference is based on an English translation thereof prepared by the United States Patent and Trademark Office. A copy of said translation is attached hereto.

Rather than reiterate the arguments of appellant and the examiner, reference is made to the briefs and answer for the respective details thereof.

OPINION

Preponderance of the evidence is the standard of proof that must be met by the Patent and Trademark Office (PTO) in making rejections of claims in a patent application (other than for "fraud" or "violation of the duty of disclosure" which require clear and convincing evidence). In re Caveney, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985).

In the instant case, while neither appellant nor the examiner has, in our view, made a strong case in arguing their respective positions, in viewing the evidence, including the arguments, as a whole, we hold that the examiner has not established, by a preponderance of the evidence, a prima facie case of obviousness. Accordingly, we will not sustain the rejection of claims 1 and 2 under 35 U.S.C. 103.

Appellant's arguments regarding "critical and unobvious advantages" of the instant invention such as reducing asynchronization and dropout of synchronizing signals caused by jitter and dropout of a read signal and increasing speed and precision of reading data [pages 6-7 of the principal brief] are not directed to specific limitations in the instant claims and, as such, are not persuasive.

Appellant's argument [page 9 of the principal brief] that Ichinoi fails to disclose or suggest a configuration according to the claimed invention, wherein the second effective time is longer than the first effective time is moot since the examiner has already admitted as much in the statement of rejection, employing Aoshima for such a teaching.

Appellant's argument [pages 9-10 of the principal brief] directed to Aoshima's teaching of widening the width of a detection window when a synchronizing signal is not detected is not, per se, convincing since the rejection is based on a combination of Aoshima with Ichinoi. Thus, appellant's arguments appear to be arguments against the references individually. This is not persuasive when the rejection is based on a combination of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

At the bottom of page 10 of the principal brief, appellant appears to argue that Ichinoi and Aoshima are not combinable because their configurations "are so significantly different," implying nonanalogous arts. If this is what was intended by appellant, we agree with the examiner that the references are most surely directed to analogous arts as they are both directed to reading data from similar recording mediums. Thus, as the examiner contends [page 4 of the answer], the references are within appellant's field of endeavor and clearly

reasonably pertinent to the particular problem with which appellant was involved. However, merely because applied references deal with analogous arts, this does not, per se, make the references properly combinable for any and all reasons under 35 U.S.C. 103.

Having set forth what we regard as deficiencies in appellant's arguments, nevertheless we will not sustain the rejection of claims 1 and 2 under 35 U.S.C. 103 because the examiner has not established a case of prima facie obviousness.

While the examiner has clearly set forth what is believed to be the difference between the primary reference to Ichinoi and the instant claimed invention (viz., the former does not disclose setting a second time period to be longer than the first time period if a synchronizing signal detection is unsuccessful) and clearly relies on Aoshima for a teaching of this deficiency [see page 3 of the answer], the examiner fails to provide a cogent rationale as to why it would have been obvious, within the meaning of 35 U.S.C. 103, to combine these references in a manner to provide the claimed subject matter.

The examiner merely states that the combination would have been obvious because such

> ...modification of setting a variable time period (variable window) is within the engineering capability of one skilled in the art in order to guarantee a synchronizing signal detection output. One skilled in the

> art would have been motivated to use the teaching of Aoshima et al. for the purpose of eliminating the need for additional window establishing making the device cheaper and portable (page 4 of the answer).

Merely because a modification "is within the engineering capability" of the skilled artisan is not a valid reason for combination under 35 U.S.C. 103. It should be recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims at bar would not have made the modification obvious unless the prior art suggests the desirability of the modification. In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

The rationale for modification that somehow the need for "additional window establishing [makes] the device cheaper and portable" is not understood. It is not understood where this is suggested by the applied references nor is it understood why establishing additional windows would make the device cheaper or portable.

The examiner has not convinced us as to why or how the skilled artisan would have applied Aoshima's teaching, wherein a window is enlarged if a synchronization signal is not detected after a certain number of counting cycles, to that of Ichinoi, wherein different windows are employed (either preset window pulse or generated by the re-synchronization window generation circuit) dependent on whether or not a leading mark is detected.

It is not clear to us how the references are being combined in order to achieve the detection of the claimed re-synchronizing pattern data within the predetermined time period, said time period being longer if detection of synchronized pattern data is not successful than if the detection of the synchronized pattern data is successful. This is what instant claims 1 and 2 require. We do not say that a case of prima facie obviousness of the claimed subject matter, based on the applied references, cannot be made, nor do we say that such a case can be made. We merely hold that the examiner in this case has not made it.

Accordingly, the examiner's decision rejecting claims 1 and 2 under 35 U.S.C. 103 is reversed.

REVERSED

ERROL A. KRASS)
Administrative Patent Judge)
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JERRY SMITH) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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MICHAEL R. FLEMING)
Administrative Patent Judge)

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